UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SUSUMU YOSHIWARA and EISEI NIGEME

Appeal No. 2004-2160
Application No. 09/818,851

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 8-13 and 19. Claims 2-7 and 15-18 stand objected to as depending from a rejected claim but are otherwise indicated as allowable, the rejections of claims 1, 15 and 16 under the second paragraph of 35 U.S.C. § 112, second paragraph, having been withdrawn by the examiner (see page 2 of the answer, mailed April 1, 2004). The rejection of claim 14 under the second paragraph of 35 U.S.C. § 112, second paragraph, has also been

withdrawn (answer, page 2). We therefore presume that claim 14 stands objected to as depending from a rejected claim but is otherwise considered allowable by the examiner.

BACKGROUND

The appellants' invention relates to construction blocks for forming an earthquake resistant structure, the blocks comprising aggregate pieces held in contact with each other by mortar above the aggregate pieces, the aggregate pieces being in firm contact with one another. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The following rejection is before us for review.

Claims 1, 8-13 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kirkpatrick.[1]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection and to the brief (filed January 16, 2004) and reply brief (filed May 4, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied Kirkpatrick patent, and to the

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[1] U.S. Pat. No. 1,487,578, issued March 18, 1924.

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Each of the independent claims 1 and 13 before us in this appeal requires the aggregate pieces within the construction block to have a circumference "in excess of 5 cm."[2] The examiner concedes that "Kirkpatrick does not specifically disclose that said circumferences are in excess of 5 cm."[3] (answer, page 4) but takes the position that It would have been obvious to one of ordinary skill in the art at the time of appellant's invention to use aggregate pieces having circumferences in excess of 5 cm "because said pieces will create firm contact between the aggregate pieces in order to transfer vibrations" (answer, page 5). For the following reason, the examiner's position is not well taken.

Kirkpatrick discloses a building block "provided with a crushed rock veneer face or the like, and provided with reinforcing elements [16, 17] to afford the block maximum strength" (lines 10-13 of Kirkpatrick). Kirkpatrick gives absolutely no indication that the crushed rock is intended to serve any purpose other than to provide an aesthetically pleasing veneer face and, in any event, provides no teaching or suggestion that the

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[2] Our review of the record indicates that this limitation first appeared in appellants' claims in the amendment filed January 22, 2003. Upon return of jurisdiction of this application back to the primary examiner, the examiner may wish to consider whether this limitation lacks written description support in the application as originally filed as required by the first paragraph of 35 U.S.C. § 112. The only mention we find of aggregate piece size in the original application is on page 9 of the specification, wherein appellants disclose three circumference ranges, namely, 50 to 60 cm (large), 20 to 40 cm (medium) and 5 to 10 cm (small). Appellants' claims, on the other hand, cover aggregate pieces of any circumference in excess of 5 cm, such as 15 cm, 45 cm or greater than 60 cm, for example.

[3] Kirkpatrick is silent with respect to the circumference or size of the "crushed rock or the like" (line 43) used to form the crushed rock veneer face 10.

crushed rock and the "smaller rocks" which fill the crevices between the rocks should or must be of any particular minimum size in order to transfer vibrations. We thus find ourselves in agreement with appellants (reply brief, pages 3-4) that the examiner's determination of obviousness stems from hindsight reconstruction and is not supported by facts of record.[4] Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). The examiner's rejection of independent claims 1 and 13, as well as claims 8-12 and 19 depending therefrom, is reversed.

[4] We cannot, however, agree with appellants that "[t]he the examiner's pronouncement of obviousness of the aggregate circumference in excess of 5 cm because 'said pieces will create firm contact between the aggregate pieces in order to transfer vibrations,' is a self-incriminating statement."

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 8-13 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. MCQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Clyde I. Coughenour
16607 Sutton Place
Woodbridge, VA 22191